

Achieving Early Grant of UK Patent Applications

This note explains the options for accelerating the prosecution of a patent application in the United Kingdom Intellectual Property Office (UKIPO).

Options for Accelerating Prosecution at the UKIPO

There is a statutory compliance period under UK patent law within which an application must be placed in order for acceptance. This differs from the European Patent Office where an application can theoretically remain pending for its entire life. The UK compliance period is 4 years and six months from the filing date or priority date, if there is one, or 12 months from issuance of the first examination report, if this expires later.

Having a UK patent application granted early is often possible. For example, it is possible to achieve grant of a UK patent application inside the first twelve months of an application. The UKIPO cannot, however, grant a patent until three months after the application has been published. Therefore if an application is to be granted early, requesting early publication may be necessary.

Prosecution of a UK patent application can be accelerated by requesting combined search and examination on filing. No justification or reason (beyond the desire for early processing) is needed to request combined search and examination. The UKIPO will issue the search report with an accompanying examination report. Requesting combined search and examination does not, of itself, mean that the application will be accelerated, although it will tend to have that effect. However, “accelerated” search and examination may also be formally requested.

Licence or Infringement

For accelerated search and examination, a request is filed with the UKIPO providing a reason for the request. Acceptable reasons are the possibility of a licence being granted but pending grant, or the existence of a potential infringer coming to light that the applicant would like to stop. Subject to such acceptable reasoning (which the UKIPO will not question, as such) the UKIPO will confirm grant of the request and begin accelerated processing.

Green Channel

If the invention relates to a ‘green’ or environmentally friendly technology, the UKIPO offers a ‘green channel’ for requesting accelerated prosecution under which no reasons need to be provided. Again, as with European applications, we have found that discussing the application with the Examiner is highly recommended.

Fast Track

For international applications entering the UK national phase, where the claims have been examined in the international phase and at least some have been found to meet the requirements of novelty, inventive step and industrial applicability, the applicant may request to use the UKIPO “fast track” procedure.

The claims on file on entry to the UK phase should sufficiently correspond to those claims found to be acceptable in the international phase. No reasons need to be provided for the request and, if the request is acceptable, the UKIPO aims to issue a substantive examination report within 2 months.

Patent Prosecution Highway

The UKIPO has entered into the Global Patent Prosecution Highway (PPH) program with selected other patent offices. The Global PPH pilot program was launched in January 2014, allowing applicants who have had claims allowed by a first participating office to request acceleration of one or more co-pending applications at any or all of the other participating offices, with all of the participating offices evaluating such requests based on the same set of agreed criteria.

A full list of the offices participating in the Global PPH can be found on the PPH Portal.

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Disadvantages

There are of course, disadvantages of accelerating prosecution. Mainly, these are that costs are incurred more quickly. Also, having a pending application is actually often more useful when there is an infringer about, because a pending application can be amended, perhaps, to better capture the infringer's activities, or a divisional application might be directed more precisely; that is, a pending application maintains the applicant's options, which are often closed once the patent is granted. Consequently, we do not advise applicants as a matter of course to accelerate prosecution, but it is an option.

If you are interested in accelerating the prosecution of your patent application then please let your HGF attorney know.